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MICHAEL RODAK, JR.,

IN THE

Supreme Court of the United States

OCTOBER TERM, 1972

No. 72-1161

GENERAL MOTORS CORPORATION,
Petitioner,

v.

DEVEX CORPORATION, *et al.*,
Respondents.

PETITIONER'S REPLY BRIEF

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As our Petition for Certiorari shows, the patent-in-suit was validated by a "narrow and restricted" claim construction, contrary to the unambiguous language of the claim. This departed from the statutory requirement that the patent claim must "particularly point out and distinctly claim" the invention. 35 U.S.C. § 112. The decision thus destroys the certainty contemplated by the statute and creates a monopoly of undefined scope. The harm to our competitive economy necessarily generated thereby is the subject of this case. Respondent's Brief in Opposition wholly fails to come to grips with this issue.

There is a square conflict between the Circuits as to what infringes the patent. Contrary to Respondent's assertions (Br. in Opp., pp. 1-2, 5, 9-10), the Seventh Circuit, having based its patent grant on unexpected coaction, had to decide—and did decide—whether proofs

of the unexpected coaction and synergism were essential to prove infringement. It overturned the summary judgment because it considered such proofs necessary to show infringement. It noted that it had held the patent valid "solely" because of the new and unexpected results, and then quoted two key paragraphs of its earlier decision that identified the specific coaction and synergistic results. *Devex Corp.* v. *Houdaille Industries*, 382 F.2d 17, 22 (7th Cir. 1967) (Pet'n A-25).

On the other hand, the court below found infringement despite trial court findings (which it did not disturb) that the specific coaction and synergistic results were not shown. It dismissed these as indecisive "disputation of chemists about chemical interactions." *Devex Corp.* v. *General Motors Corp.*, 467 F.2d 257, 261 (3d Cir. 1972) (Pet'n A-58). In short, the very same evidence that the Court of Appeals for the Seventh Circuit considered requisite to a finding of infringement was held to be irrelevant by the Court of Appeals for the Third Circuit. This is a square conflict.

Moreover, the Brief in Opposition ignores the broader economic importance of this case. This Court has noted that "the claim is required to be specific for the very purpose of protecting the public against extension of the scope of the patent." *Universal Oil Co.* v. *Globe Co.*, 322 U.S. 471, 484-485 (1944). Instead of providing such protection, the decision below in effect gives the patentee the best of two worlds. On the one hand, the patent is held valid because of an unexpected coaction not specified in the claim. On the other hand, the patent is held to be infringed by use of a different process not shown to have the unexpected coaction. This plainly conflicts both with the governing policies of our competitive economy and the patent law itself. Correction is required and this case is the appropriate vehicle for that purpose.

CONCLUSION

For the reasons stated in the Petition for Certiorari and this Reply Brief, certiorari should be granted.

Respectfully submitted,

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